

REMARKS

The present amendment is in response to the Office action dated January 23, 2007, where the Examiner has rejected claims 1-24. In the present amendment, claims 1, 7, 12, and 18 have been amended. Accordingly, claims 1-24 are pending in the present application with claims 1, 7, 12, and 18 being the independent claims. Reconsideration and allowance of pending claims 1-24 in view of the amendments and the following remarks are respectfully requested.

A. Objection To The Specification

In the Office Action, the Specification is objected to. Applicant refers the Examiner to the Preliminary Amendment filed in this matter on January 31, 2006 and requests entry of the Preliminary Amendment. Because the Preliminary Amendment addressed the above objection, the objection is now moot.

B. Rejection of Claims 1, 2, 4, 5, and 6 Under 35 USC § 101

Claims 1, 2, 4, 5, and 6 stand rejected under 35 USC section 101 as being directed to non-statutory subject matter. The Examiner states that the claims lack tangible hardware elements and could be performed, for example, on a piece of paper. Applicant has amended claim 1 to include a "display" where the media objects can be shown. Applicant submits that this tangible result directs claim 1 and dependent claims 2, 4, 5, and 6 to statutory subject matter.

C. Rejection of Claims 1-24 Under 35 USC § 103

Claims 1, 2, 4-6, 18, and 21-24 stand rejected under section 103(a) as being unpatentable over GraFX Saver Pro, <http://web.archive.org/web/20020823011437/www.cdhnnow.com/gs.html> (CDH Productions) in view of How To Write A 32 Bit Screen Saver <http://www.wischik.com/scr/howtoscr.html> (Wischik). Claim 3 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of U.S. Patent No. 6,493,743 (Suzuki). Claims 7, 9, 12, 13, 15, and 16 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of U.S. Patent No. 6,421,235 (Ditzik). Claim 8 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of U.S. Patent Application No. 2002/0055992 (King). Claim 10 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of U.S. Patent Application No. 2003/0169306 (Makipaa). Claims 11 and 14 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of U.S. Patent No. 6,810,115 (Fukuda). Claim 17 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik in further view of King. Claims 19 and 20 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of King. The rejections are traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness. First, there must

be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

In the Office Action, no motivation has been supplied for combining the references. With respect to the independent claims 1 and 18, the foregoing rejections all rely on CDH productions and Wischik. With respect to the independent claims 7 and 12, the foregoing rejections rely on the same references in addition to Ditzik for the disclosure of a wireless device.

The present independent claims 1, 7, 12, and 18 are directed to not only arranging and playing a media production on a device, but also to playing different media productions in response to different trigger events. For example, a first media production might play when the battery is low, while another media production might play when the device receives a call. (See, page 10 of the present Application).

CDH productions is directed to developing screen savers. Wischik is directed to playing a screen saver in response to a trigger event. Even if CDH productions could be combined with Wischik, however, it would still not motivate someone having skill in the art to create an association such as a "list" to associate the media productions with the different trigger events.

For example, Wischik describes the process for creating a screen saver for a Windows environment. Even if the trigger events include inactivity or moving the mouse to one of four corners on the screen, the same "media production" or screen saver occurs. In the windows environment, the screen saver is set in the control panel, then each time the trigger event happens, the screen saver that is set in the control panel is played.¹

Even if one combined CDH Productions with Wischik, there still is no motivation to create an association list between trigger events and media productions because in Wischik, the same screen saver is always associated with all of the potential trigger events. For at least that reason, there is no suggestion or motivation to combine CDH Productions with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success, which is the second requirement of the obviousness analysis. For example, even if CDH Productions could be combined with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda, it would still not result in an association list between trigger events and media productions as is presently claimed.

For example, the trigger events taught by Wischik are in a 32 bit Windows environment where all the trigger events cause the same screen saver to be invoked.

¹ See, for example, "When and Where to Save Configuration" section of Wischik where it states: "whenever a user brings up the configuration dialog for a particular saver and clicks OK, then the changes to the configuration for that particular saver are written to the registry immediately. But the current choice of screen saver appears in the control panel itself and changes to it do not actually take effect, or get written to the registry, until the user clicks OK or Apply on the Desktop control panel itself! . . . So someone might select a saver and spend ages configuring it but then fail to close the control panel: and when they use hot corners to see the effect immediately Windows will not launch the saver they had so painstakingly configured, but instead will launch the previous saver!"

(i.e., the screen saver set in the control panel). In such a case no association list is needed because the default screen saver would always be associated with each trigger event so such an association list would waste memory and serve no function. In fact, if such a table listed the trigger events in one column and the screen saver in another column, the screen saver column would always be the same because the default screen saver is always invoked. This would cause the processor to process data unnecessarily and slow down the system with wasted instructions. Therefore, the proposed combination of CDH Productions with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda does not create a reasonable expectation of success.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. None of the references teach accessing a list identifying an association between a trigger event and an ordered sequence of media objects. Each of the independent claims 1, 7, 12, and 18 contain language similar to the above step of accessing.

CDH Productions does not teach a trigger event at all. Wischik teaches only a Windows screen saver where each trigger event is always associated with a default screen saver set in the control panel. As such, the trigger event is always directed to the same screen saver. In such a scenario there is no purpose for a list associating the screen saver with the trigger event.

Even if Suzuki can publish the screen saver to a remote device, it still does not perform the step of accessing as defined by the claims because even if the screen saver is published elsewhere, it is still always invoked in response to any and all trigger events as in Wischik.

Even if Ditzik uses a wireless device, it still does not perform the step of accessing as defined by the claims. Whether the screen saver is on a wireless device or a home PC, Ditzik and in particular Ditzik combined with Wischik performs a 32 bit Windows screen saver on a mobile device. In such a scenario, the default screen saver is always played in response to any and all trigger events, so no association list is used.

Even if King uses a GPS location, it merely describes the nature of one potential trigger event. Even if GPS is used as a trigger event, King when combined with the 32 bit Windows screen saver in Wischik still does not perform the step of accessing as defined by the claims, since even if GPS is added as a trigger event the same screen saver (as taught by Wischik) plays regardless of how trigger events are defined.

Even if Makipaa uses a call processor, it still does not perform the step of accessing as defined by the claims. For example, claim 10 states that an embedded processor presents the media objects responses to a trigger event generated by the call processor. Even if the call processor in Makipaa performed such a step, the media objects responses will still always be the same screen saver, since Makipaa is combined with Wischik. Wischik defines a 32 bit Windows screen saver. As such, all responses to the call processor would be for the same screen saver, so no association list would be used.

Even if Fukuda uses caller identification information, it still does not perform the step of accessing as defined by the claims. Fukuda plays ring tones depending on a particular caller and such ring tones are not media presentations or screen savers as is presently claimed.

Therefore, the pending claims (1-24) are not obvious under CDH Productions in the cited combinations.

D. Conclusion

For all the foregoing reasons, an early allowance of claims 1-24 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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